



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,191	11/20/2001	D. Wade Walke	LEX-0270-USA	4055
7590 01/28/2004			EXAMINER	
Lance K. Ishimoto Lexicon Genetics Incorporated 4000 Research Forest Drive The Woodlands, TX 77381			DEBERRY, REGINA M	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/997,191

Applicant(s)

WALKE ET AL.

Examiner

Regina M. DeBerry

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 01 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-6 (see 10 below).

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 5. does NOT place the application in condition for allowance because:


Claims 1-6 stand rejected under 35 USC 101. The rejections are maintained for reasons of record. Applicants request examination and reconsideration of the application in view of the following remarks. Applicants state that the present situation appears to track Example 10 of the Revised Interim Utility Guidelines Training Materials. The arguments have been fully considered but not found persuasive because as was stated in last Office Action, the specification fails to teach the specific role of WNT 14 in cancer. In Example 10 of the Utility Guidelines Training Material, the specification taught the sequence as being a DNA ligase. The instant specification states "Wnt family proteins have been implicated in a number of biological processes such as cancer (page 1, line 26). Thus specific utilities were not asserted in the instant specification as originally filed. Applicants reiterates the "role" WNT 14 has in cancer and discusses cancer research. These arguments are not found persuasive because Applicants failed to disclose at the time the specification was originally filed the role WNT 14 plays in cancer.

Applicants state that presently described polymorphisms are useful in forensic analysis to identify members of the human population based on the presence or absence of one or more of the described polymorphisms. Applicants state that the ability to eliminate 50% of the population from a forensic analysis clearly is a real world practical utility. The arguments have been fully considered but not found persuasive because an assay that measures the presence of a material which has a stated correlation or a predisposition to the onset of a particular disease/condition would define a real world context in the use of identifying potential candidates for preventive measures or further monitoring. However, identifying people based on the presence or absence of a polymorphism would not define a real world utility.

Applicants state that SEQ ID NO:1 can be used to map the 4 coding exons on chromosome 1. As was stated in the last Office Action, a specific utility is one that is specific to the subject matter claimed. Applicants cite Carl Zeiss Stiftung v. Renishaw PLC which deals with patent invalidity and patent infringement. The Examiner has already discussed high-throughput chip. Regarding gene chips, Applicants state that the skilled artisan would readily understand the meaning if the presently claimed sequence, which has been detected in a number of cancer lines (Kirikoshi) was found to be expressed at a greater level in cancer tissues compared to normal tissue. The arguments have been fully considered but not found persuasive because the specification at the time of filing did not teach any information regarding WNT polynucleotide or polypeptides levels in cancer cells. As was stated in the last Office Action, each Patent application is examined on its own merits, what was allowable in one Patent, has no bearing on this application. The scientific reasoning and evidence as a whole indicates that the rejection should be maintained.

Claims 1-6 stand rejected under 35 USC 112, first paragraph. The rejections are maintained for reasons of record. Applicants incorporate their response to the rejection under 35 USC 101 in response to the rejection under 35 USC 112, first paragraph. Applicants' arguments have been fully considered but are not found persuasive for the reasons discussed above in the maintained rejection under 35 USC 101.

Continuation of 10. Other: No claims have been cancelled. No claims have been amended. No new claims have been added.


GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600